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09/917,998	07/30/2001	Marco Steiger	G 3752	1503

7590

08/19/2003

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EXAMINER

MCDONALD, SHANTESE L

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 08/19/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/917,998

Applicant(s)
Steiger et al.

Examiner
McDonald, Shantese

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3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 7, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3,6,9,10, 13,15-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fletcher et al.

Fletcher et al. teaches a tool for use with a manually operable material removal apparatus comprising a flat elongated member, 10, having a first section, 12, provided with an aperture, 14,15,16, which allows the member to be mounted on an output shaft, and a second section, 8, remote from the first section and including material removing cutting teeth, 2. Fletcher et al. also teaches that cutting teeth are formed by adjoining two straight cutting edge sections at acute angles, (fig. 2). Fletcher et al. also teaches a slot, 24, provide for facilitating removal of cut material, provided in the elongated member between the first and second sections. Fletcher et al. teaches that the elongated member has a substantially constant width at least between the first and second sections, (fig. 1), and the member having a substantially trapeziform outline, (fig. 6a), and the elongated member comprising a third section, disposed between the first and second sections

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having a first width, at least one of the first and second sections having a second width different from the first width, (fig. 6a).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Arntz et al.

Fletcher et al. teaches all the limitations of the claims except for the material removing elements comprising diamonds and corundum. Arntz et al. teaches material removing elements, 35, comprising diamonds and corundum, (col. 4, lines 55-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material removing elements of Fletcher et al. with diamond and corundum, as taught by Arntz et al., in order to enhance the elements removing capabilities, and to make them more durable.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al.

Fletcher et al. teaches all the limitations of the claims except for the acute angle being between 1.5 and 4.6 and 1.5 and 2 degrees. It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to make the acute angle of Fletcher et al. between 1.5 and 4.6 and 1.5 and 2 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al in view of Nitz et al.

Fletcher et al. teaches all the limitations of the claims except for the elongated section being provided with a step intermediate the first and second sections, the step having a predetermined height and further comprising a fastener arranged to attach the first section to the shaft and extending beyond the elongated member through a distance at least approximating the height. Nitz et al. teaches the above limitation, (fig. 10, col. 4, lines 66 and 67 and col. 5, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Fletcher et al. with an elongated section being provided with a step intermediate the first and second sections, the step having a predetermined height and further comprising a fastener arranged to attach the first section to the shaft and extending beyond the elongated member through a distance at least approximating the height, as taught by Nitz et al. in order to enhance the range of the tools cutting capabilities.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Miller et al.

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Fletcher et al. teaches all the limitations of the claims except for the at least one cutting edge having a first and second ends and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections. Miller et al. teaches a cutting edge with the limitations cited above, (fig. 5B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Fletcher et al. with at least one cutting edge having a first and second ends and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, as taught by Miller et al., in order to enhance the range of the tools cutting capabilities.

8. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Fisher.

Fletcher et al. teaches all the limitations of the claims except for a tool kit containing a plurality of discrete tools having different parameters . Fisher et al. teaches a tool kit containing a plurality of discrete tools, (abstract, lines 8-9 and col. 1, lines 12-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Fletcher et al. with a tool kit, as taught by Fisher, in order to vary the cutting capabilities based on the variation of the intended use.

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Response to Arguments

9. Applicant's arguments filed 8/8/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the tool is used for the removal of material from workpieces, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In reference to the limitation that "the cutting edge is arranged to make in a workpiece a cut having a width which is a function of several parameters", any object that makes cuts, would perform this limitation, Fletcher states that the blade is for use with an oscillatory power tool, therefore if the tool is oscillating, then the cuts made would make cuts having a width which is a function of several parameters.

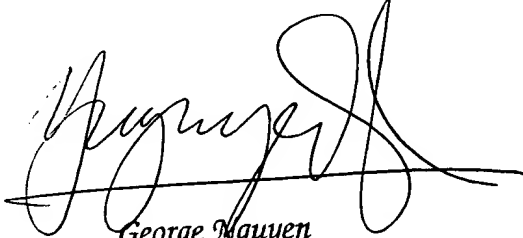
In reference to an amendment filed 8/7/03, the applicant has brought to the examiner's attention that the rejection of claims 18-20 were in error. The Examiner has corrected the error, and is re-issuing the final rejection.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese McDonald whose telephone number is (703) 308-8722.



George Nguyen
Primary Examiner

S.L.M.

August 14, 2003